

FEB - 5 1999



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#14

CHARLES A MCCLURE
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In re Application of :
Anthony Smith :
Application No. 08/506,851 : Letter Regarding
Filed: July 25, 1995 : Extension of Patent Term
For: Hospital Liquid Sanitation :
Cart

The above-identified application has been forwarded to the undersigned for correction of the patent term extension information printed on the Notice of Allowance and Issue Fee due that was mailed on October 20, 1998.

Issue of the above-identified application was delayed due to appellate review by the Board of Appeals and Interferences, and the above-identified application has been allowed pursuant to a decision of the Board affirming-in-part an adverse determination of patentability.

35 U.S.C. § 154 states, in part:

(b) TERM EXTENSION.-....

(2) EXTENSION FOR APPELLATE REVIEW.-If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(3) LIMITATIONS.-The period of extension referred to in paragraph (2)-

(A) shall include any period beginning on the date on which an appeal is filed under section 134 or 141 of this title, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant;

(B) shall be reduced by any time attributable to appellate review before the expiration of 3 years from the filing date of the application for patent; and

(C) shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

37 C.F.R. § 1.701 states, in part:

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(3) appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review....

(c) (3) The period of delay under paragraph (a) (3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences,...

(d) The period of delay set forth in paragraph (c) (3) shall be reduced by:

(1) any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and

(2) any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

A Notice of Appeal was filed in the above-identified application on March 21, 1997. On August 26, 1998, the Board of Appeals and Interferences reversed the decision of the examiner in the above-identified application. Since the above-identified application was filed after June 7, 1995 and issuance of the application as a patent was delayed due to appellate review resulting in a reversal

of an adverse decision of patentability, the patent to issue from the application is entitled to an extension of the patent term. The period of delay in the above-identified application is 524 days, the period beginning on March 21, 1997, the date that the Notice of Appeal was filed, and ending on August 26, 1998, the date of the final decision in favor of the applicant. The period of delay is required to be reduced pursuant to 35 U.S.C. § 154(b)(3)(B) and 37 CFR 1.701(d)(1) in calculation of the patent term extension. As a result, the period of extension has been calculated to be 33 days (counting July 25, 1998 (three years after the filing date of the application) and each day up to and including August 26, 1998).

After mailing of this decision, the above-identified application will be returned to Office of Publications for further processing. The patent, if issued, will include an indication that the patent term is extended by 33 days not 524 days as stated on the Notice of Allowance.

The above-identified application will be returned to the Office of Patent Publication after this decision is mailed.

Telephone inquiries with regard to this communication should be directed to the undersigned at (703) 305-9285.



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Office of the Deputy Assistant Commissioner
for Patent Policy and Projects